

Appl. No. 10/715,752
Atty. Docket No. CM2543CQ
Amdt. dated January 30, 2006
Reply to Office Action of Oct. 28, 2005
Customer No. 27752

Amendments to the Drawings:

The attached sheet of drawings includes new Figure 1B. In Figure 1B, the multitude of applicators and multitude of beads are shown. The attached sheet of drawings are attached to this paper after page 22.

Attachment:

New Sheet

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REMARKS

Claim Status

Claims 1 - 21 are pending in the present application. No additional claims fee is believed to be due.

Claims 1 and 2 have been amended to more specifically characterize the present invention. Support for the amendments can be found in the specification, for example, on page 20, lines 20-21. Claim 12 has also been amended to more specifically characterize the present invention. Support for the amendment can be found in the specification, for example, on page 11, lines 12-14.

Claims 1, 2, 6, and 8 have been amended to correct transcriptional errors. Support for the amendments can be found in the claims as originally filed, for example.

Claims 15-21 have been withdrawn as a result of an earlier restriction requirement.

The specification has been amended on page 8, line 11; page 9, lines 21-26; page 30, lines 23-27. Support for the amendments can be found in the specification, for example, the locations provided with regard to the addition of Figure 1B). Additionally, the specification has been amended on page 20, lines 10-13. Support for this amendment can be found in the specification as filed, for example.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Response to Requirement for Restriction of Inventions

The Examiner has required, under 35 USC §121, election of a single disclosed invention for prosecution on the merits. A provisional election with traverse was made via telephone on October 4, 2005, to prosecute the invention of Group I. This hereby confirms the election to prosecute the invention designated in the Office Action as Group I. This election is made without traverse. Claims 1-14 are drawn to this invention.

Claims 15-21 have been canceled by this amendment as being drawn to a non-elected invention.

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Objections to the Drawings

The Office has objected to the drawings under 37 CFR § 1.83(a) for failing to show every feature of the invention specified in the claims. Specifically, the drawings are objected to because they fail to show the "multitude of applicators" claimed in the present invention. Applicants submit herewith this response a new sheet which depicts the "multitude of applicators".

Support for this new sheet can be found in the specification. Some examples include page 9, lines 21-26; page 9-10, lines 33-34 and lines 1-2, respectively; and page 30, lines 23-24.

Objection to the Specification

The Office has objected to the abstract of the specification for various grammatical errors and for non-compliance with MPEP § 608.01(b). Applicants submit herewith an amended abstract in accordance with MPEP § 608.01(b).

Objection to the Claims

The Office has objected to claim 2 because of a transcriptional error. Applicants have amended claim 2 and corrected the identified error.

Rejection Under 35 USC §112, Second Paragraph

The Office has rejected claims 1, 6, 8, and 14, under 35 U.S.C. § 112, second paragraph "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." (Office Action page 5). Applicants have amended claims 1, 6, and 8, and assert that these claims meet the requirements of 35 U.S.C. § 112, second paragraph.

Regarding claim 14, the Office states that "[t]he articles are undefined by the claims, therefore it is inappropriate to assume the correct selection of the articles where the melting temperature is higher than that of the first tool." (Office Action, page 6). Applicants respectfully disagree with the assertion by the Office.

First, Applicants respectfully point out that claim 14 recites, in part, that the "temperature of the surface of the first tool is higher than the melting temperature of the article, series of articles or web of articles."

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Second, the MPEP states, with regard to rejections under 35 U.S.C. § 112, second paragraph, that “[t]he essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” MPEP § 2173.02. Additionally, “[i]n reviewing a claim for compliance... , the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of the scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph.” *Id.*

The preamble of claim 1, from which claim 14 indirectly depends recites, in part, “[a] process for applying an active material onto an article, series of articles or web of articles.” Additionally, the specification, on pages 24-30 adequately describes the possible articles. Based on the foregoing, Applicants assert that claim 14 apprises one of ordinary skill in the art of the scope of the claim and serves the notice function required by 35 U.S.C. § 112, second paragraph.

For the foregoing reasons, Applicants respectfully request the withdrawal of the rejection of claims 1, 6, 8, and 14, under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 USC §102 Over Hefe

The Office has rejected claims 1, 2, 3, 6, 9, and 11, under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,141,313 issued to Hefe, hereafter, “Hefe”. Applicants respectfully traverse the rejection by the Office.

Case law has held that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Hefe fails to teach all of the claim elements of the claimed invention.

First, amended claim 1 recites, in part, “heating the coater unit such that the active material is applied at a temperature of between 70 degrees C and 250 degrees C.” In contrast, Hefe teaches “[a] process and apparatus for the patterned deposition of powdered thermoplastics adhesive material on the outer surface of a textile.” (Abstract). Additionally, Hefe teaches that “[s]ince the take-off roller 5 is usually heated, the side wall 12 of the powder container 10 which lies adjacent the roller 5 is provided with a

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water cooling arrangement 17.” (col. 5, lines 55-58). Thus, Hefele does not teach a coater unit which is heated, as is recited, in amended claim 1.

Second, amended claim 1, recites, in part, that the coater applies “said active material to a surface of a first tool in the form of a multitude of beads.” In contrast Hefele does not teach applying active material in the form of a multitude of beads.

Third, amended claim 1, recites, in part, that the coater unit has “a multitude of applicators that are in close proximity to the surface.” In contrast, Hefele teaches two powder containers 10 and 11. However, Hefele does not teach that the containers comprise a multitude of applicators.

For the foregoing reasons, Hefele does not teach all of the claim elements of amended claim 1. Accordingly, Applicants assert the Hefele does not anticipate amended claim 1.

Similarly, amended claim 2 recites, in part, “wherein the coater is heated such that the active material is applied at a temperature between 70 degrees C and 250 degrees C.” As stated above with regard to amended claim 1, Hefele fails to teach a heated coater unit. Accordingly, Applicants assert that Hefele does not anticipate amended claim 2.

Similarly, amended claim 6 recites, in part, “wherein the coater comprises a multitude of extruder-applicators which provide a multitude of extruded beads of the active material, and wherein the extruder-applicators have a pitch of less than 15 mm.” The pitch is defined as “the shortest distance between the middle of one applicator opening to the next, in a direction of a row of applicators.” (page 20, lines 10-11). As stated previously, Hefele does not teach a multitude of applicators. Consequently, Hefele also does not teach a pitch between one applicator and the next applicator in a row. Accordingly, Applicants assert the Hefele does not teach all of the claim elements of amended claim 6.

For the foregoing reasons, Applicants assert that amended claims 1, 2, and 6, are not anticipated by Hefele. Additionally, because claims 3, 9, and 11, depend from either amended claims 1, 2, or 6, claims 3, 9, and 11, are similarly not anticipated by Hefele. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1, 2, 3, 6, 9, and 11 under 35 U.S.C. § 102(b).

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Rejection Under 35 USC §103(a) Over Lender et al. in view of Hefe

Claims 1, 7, and 14, are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP Publication No. 0978263 A1, filed on behalf of Lender et al., hereafter "Lender", in view of Hefe. Applicants respectfully traverse the rejection by the Office.

It is well settled that in order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.*

First, Applicants respectfully traverse the rejection by the Office because the proposed modification of Lender is not sufficient to render the claims *prima facie* obvious. Case law provides that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). In this case, the court reversed an obviousness and held that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." *Id.* (citing 270 F.2d at 813, 123 USPQ at 352).

Lender teaches a process for providing a disposable absorbent article, wherein the process utilizes an improved roll printing process to provide adhesive. (Abstract). Lender teaches that the "temperature of the adhesive at application is greater than the temperature of the printing roll." [0015]. Lender further teaches that "[t]he adhesive is applied in a liquefied state, typically achieved by melting." [0017]. In contrast, as stated previously, Hefe teaches that powder container 10 and powder container 11 are provided with a water cooling arrangement 17 so that the heat from the roller 5 is kept away from the inside of the powder containers. (col. 5, lines 55-60; col. 6, lines 12-15).

Because Lender teaches the use of an adhesive in the liquefied state and Hefe teaches the use of an adhesive in a powdered state, the proposed modification by the Office would change the principle operation of the process taught by Lender. Namely,

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the process of Lender would have to be modified such that adhesive could be applied in a powder form instead of in liquefied form. Consequently, Applicants assert that the proposed modification to Lender would change the principle operation of Lender. Therefore, Applicants assert that the proposed modification is not sufficient to establish a *prima facie* case of obviousness.

Second, Applicants respectfully traverse the rejection by the Office because the proposed modification would render the modified reference unsatisfactory for its intended purpose. Case law provides that "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Lender teaches that one of the problems with current roll printing "is that the amount and distribution of adhesive which is deposited from the print roll onto the substrate is extremely difficult to control." [0013]. In a discussion of stringing of adhesive (a problem with printing adhesives), Lender teaches that "[t]his problem is further exacerbated when the printing process is operating at low temperatures." [0013]. Lender further teaches that by "providing the adhesive onto the roll at a temperature greater than that of the operational roll temperature...the amount of adhesive transferred from the roll to the surface... can also be controlled." [0038]. Additionally, Lender teaches that the elevated temperature is believed to reduce stringing of the adhesive. [0038].

As stated above, Lender recognizes the higher temperature of the adhesive as alleviating several problems of prior art printing process and as beneficial to the process. In contrast, Hefele suggests that the temperature of the adhesive should be shielded from the heat via a water cooling arrangement 17. Consequently, Applicants assert that the proposed modification would render Lender unsatisfactory for its intended purpose. Accordingly, Applicants assert that there is no motivation to make the proposed modification.

Third, there is no motivation to combine the suggested references because the Lender teaches away from a combination with Hefele. Case law provides that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." See

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United States v. Adams, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). Additionally, if a reference is found to teach away from a suggested combination, then there is no motivation to make the suggested combination. See *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

As stated previously, Lender teaches that by "providing the adhesive onto the roll at a temperature greater than that of the operational roll temperature...the amount of adhesive transferred from the roll to the surface... can also be controlled." [0038]. In contrast, as stated above, Hefele teaches that the powdered adhesive should be shielded from the heat of the take-off roller 5 and the feed roller 4. (col. 5, lines 55-60; col. 6, lines 12-15).

Additionally, as stated previously, Lender teaches that "[t]he adhesive is applied in a liquefied state, typically achieved by melting." [0017]. In contrast, Hefele teaches that the adhesive is applied in powdered form. (Abstract; col. 1, lines 30-33; col. 5, lines 24-25; and col. 6, lines 48-53).

For the foregoing reasons Lender teaches away from a combination with Hefele. One of ordinary skill in the art would be dissuaded from incorporating the teachings of Hefele in lieu of the teachings of Lender. Accordingly, Applicants assert that there is no motivation to make the suggested combination of Lender and Hefele.

Claim 7:

Regarding claim 7, the Office states that:

The difference between Lender et al. in view of Hefele and claim 7 is the operation of a take-off roller above 30 degrees Celsius. Lender et al. teaches the guiding roller to neither be heated nor cooled, therefore it is appreciated that the operation takes place in room temperature, approximately 25 degrees Celsius.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the take-off roller at room temperature. One would have been motivated to do so because it would not require further energy or expense to maintain the roller at room temperature.

(Office Action page 9).

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Applicants respectfully traverse the rejection by the Office because there is no motivation to combine Lender and Hefe. Claim 7 recites, in part, that "the surface of the second tool has a temperature of between 0 degrees C and 30 degrees C." Lender does not appear to teach a specific temperature range for the guiding roller. However, Hefe teaches that the take-off roller 5 can be at temperatures of 80 degrees C without the second blade or at a temperature of 120 degrees C with the second blade. (col. 8, lines 26-27; col. 9, line 6). Additionally, Hefe teaches that the feed roller 4 can be at a temperature of 220 degrees C. (col. 8, line 25; col. 9, line 6). Consequently, regardless of energy concerns, one of ordinary skill in the art, would be dissuaded from combining the teachings of Lender and Hefe. Accordingly, Applicants assert Hefe teaches away from a combination with Lender. Thus, Applicants assert that there is no motivation to combine the suggested references.

Claim 14:

Regarding claim 14, the Office states:

The difference between Lender et al. in view of Hefe and claim 14 is using articles with a melting temperature of the articles lower than the engraving roller. While Lender et al. does not specifically detail that the heated roller is heated to a temperature above the melting temperature of the web or article, it is appreciated that the web or article used in Lender et al. can be a variety of materials with a variety of melting points.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use articles with a melting temperature lower than the engraving roller. One would have been motivated to do so since the roller will effectively soften the web and then allow the adhesive to adhere thereto more effectively only if the heated roller is kept at a temperature higher than the article temperature.

(Office Action, page 10).

Applicants respectfully traverse the rejection by the Office because the Office appears to be taking official notice improperly and has therefore not provided any motivation to combine. The MPEP and case law provide much guidance as to when official notice is proper. In limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record or to rely on 'common knowledge' in making

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a rejection, however such rejection should be judiciously applied.” MPEP §2144.03. Official notice may be taken without supporting documentary evidence only when the “facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known.” *Id.* (citing *In re Ahlert*, 424 F.2d 1088). “It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” *Id.* (citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)).

Applicants respectfully assert that the Office has inappropriately relied on its statement of motivation as the principal evidence upon which its rejection was based. Accordingly, Applicants respectfully request that the Office provide evidentiary support for its assertion that softened webs allow adhesive to adhere thereto more effectively. Because the Office has improperly relied on official notice, the Office has failed to factually support a conclusion of obviousness with regard to claim 14.

For the foregoing reasons, Applicants assert that claims 1, 7, and 14, are nonobvious over the suggested combination of Lender in view of HefeLe.

Rejection Under 35 USC §103(a) Over HefeLe in view of Lender and Friesch

Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over HefeLe in view of Lender and U.S. Patent No. 5,064,492, issued to Friesch, hereafter, “Friesch”. Applicants respectfully traverse the rejection by the Office.

For the reasons stated above regarding the rejection of claims 1, 7, and 14, as unpatentable over Lender in view of HefeLe, Applicants assert that Lender teaches away from a combination with HefeLe; that the proposed modification of Lender by HefeLe would change the principle operation of Lender; and the proposed combination of Lender and HefeLe would render Lender unsatisfactory for its intended purpose. Accordingly, Applicant asserts that there is similarly no motivation to combine HefeLe, Lender, and Friesch.

Even assuming *arguendo* that there was motivation to combine Lender and HefeLe, the Office would still fail to establish a *prima facie* case of obviousness against claim 4 because there is no motivation to combine HefeLe and Friesch.

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Friesch teaches a process for preprinting an adhesive on a surface film. (col. 3, lines 42-43). Friesch teaches that a printing or transfer cylinder 103 can transfer prints adhesive directly to the film. (col. 3, lines 54-56). However, in contrast to Hefe, Friesch also teaches that “[i]n order to maintain proper tension and to assist in cooling the adhesive after application, a chill roll 104 is preferably located directly beneath each printing cylinder 103.” (col. 3, lines 56-59).

In contrast, as stated previously, Hefe teaches that the take-off roller 5 can be at temperatures of 80 degrees C without the second blade or at a temperature of 120 degrees C with the second blade. (col. 8, lines 26-27; col. 9, line 6). Additionally, Hefe teaches that the feed roller 4 can be at a temperature of 220 degrees C. (col. 8, line 25; col. 9, line 6).

One skilled in the art upon reading Hefe and Friesch would be discouraged from implementing the chilled roll of Friesch because of the teachings of a heated take-off roll and heated feed roll by Hefe. Accordingly, Applicants assert that there is no motivation to combine Hefe in view of Lender and Friesch. Therefore, Applicants assert that the Office has failed to establish a *prima facie* case of obviousness against claim 4.

Rejection Under 35 USC §103(a) Over Hefe in view Kaylor et al.

Claims 8, 10, 12, and 13, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hefe in view of U.S. Patent Application Publication 2003/0138570 filed on behalf of Kaylor et al., hereafter, “Kaylor”. Applicants respectfully traverse the rejection by the Office.

Hefe teaches away from a combination with Kaylor. As discussed previously, Hefe teaches “[a] process for the patterned deposition of powdered thermoplastics adhesive material on the outer surface of a textile.” (Abstract). Kaylor teaches a process for manufacturing biosensor films. (Abstract). Kaylor teaches the application of a receptor solution 5 to the surface of the gravure cylinder. [0047]. Kaylor teaches that the receptor solution includes a receptor and a carrier fluid. (Abstract). After reviewing Kaylor, Applicants were unable to locate any reference regarding the receptor solution comprising an adhesive. Additionally, Hefe makes no mention of a fluid in the application of its powdered adhesives.

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Accordingly, Applicants assert that one skilled in the art, upon reading Kaylor would be discouraged from incorporating the teachings of Kaylor in the process of HefeLe.

Claim 8:

As stated previously, HefeLe alone fails to teach all of the claim elements of claim 6 from which claim 8 depends. Additionally, there is no assertion by the Office that Kaylor teaches all of the claim elements of claim 6. Consequently, Applicants assert that the suggested combination of HefeLe and Kaylor fail to teach or suggest all of the claim elements of claim 6 and therefore also fails to teach or suggest all of the claim elements of claim 8.

Claim 10:

As stated previously, HefeLe alone fails to teach or suggest all of the claim elements of amended claim 1 from which claim 10 indirectly depends. As there is no assertion by the Office that Kaylor teaches or suggests any of the claim elements which HefeLe lacks, Applicants assert that the suggested combination of HefeLe and Kaylor fail to teach or suggest all of the claim elements of amended claim 1. Therefore, Applicants assert that the suggested combination of HefeLe and Kaylor fail to teach or suggest all of the claim elements of claim 10 also.

Claim 13:

The Office states that HefeLe fails to teach "rotating the article around the take-off roller, which exits at a specified angle." (Office Action, page 12). The Office asserts that Kaylor teaches a contact angle of active material from about 30 degrees to about 75 degrees. The Office then states that as shown in Figure 1 the contact angle and its complementary angle are relatively congruent to each other and that the exit angle is therefore obvious. Applicants respectfully traverse the rejection by the Office.

It is well settled that drawings and pictures can be used as prior art. MPEP §2125. However, in order for a drawing or picture to anticipate a claim, the drawing or picture must clearly show the claimed structure. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). Additionally, where "the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing

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features are of little value.” MPEP §2125 citing *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000).

Applicants assert that reliance on the Figures of Kaylor is improper because Kaylor fails to state that the figures are to scale. Consequently, Applicants assert that the suggested combination of Hefele and Kaylor fail to teach or suggest all of the claim elements of claim 13.

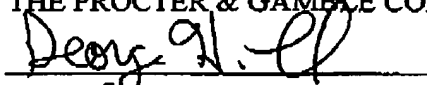
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph, § 102(b), and § 103(a). Early and favorable action in the case is respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Signature

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